

Remarks/Arguments

The Rejection of Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 Under 35 U.S.C. §103

The Examiner rejected Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) in view of U.S. Patent No. 6,947,909 (Hoke Jr.) and further in view of U.S. Patent No. 6,401,206 (Khan et al.).

Claim 11

Rivette does not teach a searchable database in communication with a publication Web site

Arguments regarding Rivette and a searchable database in communication with a publication Web site were presented in the Request for Reconsideration dated September 26, 2006. In the interest of brevity, the arguments are referenced, but not repeated.

Donner does not teach receiving a product document

Arguments regarding Donner and a product document were presented in the Request for Reconsideration dated September 26, 2006. In the interest of brevity, the full arguments are referenced, but not repeated.

Donner does not teach the publicly accessible database of Claim 11

Arguments regarding Donner and a publicly accessible database were presented in the Request for Reconsideration dated September 26, 2006. In the interest of brevity, the full arguments are referenced, but not repeated.

There is no motivation to combine Rivette and Donner

"Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot

be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 16 U.S.P.Q.2d 1430. Thus, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. *In Re Lee, supra*.

“When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).” (MPEP 2141(II)) (emphasis added).

The Examiner stated: “It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to form an IP portfolio utilize material in the *public domain*.” (emphasis added). Since Rivette is the primary reference, the Examiner is stating that it would have obvious to modify Rivette to form a portfolio in the public domain. There is no basis for this statement. Rivette only teaches a closed, confidential database. Not only does Rivette not have any motivation to form a portfolio in the public domain, such a portfolio could well be disastrous from a business and legal viewpoint. As has been shown, Rivette actually teaches against public disclosure of data. Further, Rivette does not contain any motivation to modify another database to form a portfolio in the public domain. Such a portfolio is simply outside of any teaching, suggestion, or motivation that can be attributed to Rivette.

Rivette does not suggest or motivate making the database of Figure 3, which contains highly confidential information, some of which is legally required to remain confidential, publicly accessible or linked to a publication website. Donner has no suggestion to make an otherwise confidential and protected database publicly accessible.

“The recognized law for combining references to support the conclusion that the claimed combination of structural features is directed to obvious subject matter requires that either the references expressly or impliedly teach or suggest the claimed combination, or the Examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *See e.g., Ex parte Clapp*, 227 USPQ 972 (973) (PTO Br Pat. App. & Int. 1985); *In re Geiger*, 2 USPQ2d 1276 (CA, Fed. Cir. 1987).”

It is clear that the motivation to combine Rivette and Donner is not contained in Rivette or Donner. Thus, the Examiner must provide a convincing line of reasoning. In this regard, the Examiner stated: “It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method *in order in order to decrease the latency in document processing by utilizing electronic transmission means.*” (emphasis added). This statement is clearly nonsensical with respect to the teachings of both Rivette and Donner. That is, both **Rivette and Donner already use electronic transmission means**. For example, Rivette shows network 312 in Figure 3, in which data is electronically transmitted and Donner teaches electronic transmission between device 4 and databases 5 in Figure 1. Alternately stated, the use of electronic transmission means as a motivation to modify or combine references is clearly inapplicable since the references already use electronic transmission means.

In fact, the Examiner has explicitly cited both of these electronic transmission arrangements. For example, the Examiner stated: “Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of: providing a searchable document database and a publication Web site in communication with a document database;(Figures 2 and 3).” This is exactly an electronic transmission means. The Examiner also stated: “Donner ('725) discloses “*electronically receiving said product document transmitted by a client's computer,(Figure 1) and publishing said client document by adding said client document to said document database*”.(Figure 2)” (emphasis added). This is clearly an electronic transmission.

Thus, the Examiner has failed to provide any motivation or suggestion to combine or modify the references.

The Examiner has applied impermissible hindsight

“When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) **The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention**; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).” (MPEP 2141(II) (emphasis added).

“Moreover, deficiencies of the cited references cannot be remedied by general conclusions about what is “basic knowledge,” or “common sense.” *Id.* Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention ... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Id.* *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983).”

As noted *supra*, there is no teaching, suggestion, or motivation in the cited references to modify Rivette to form the claimed invention, nor is there any convincing reason as to why an artisan would be motivated to combine the references. Therefore, any suggestion or motivation to modify Rivette is derived from Applicants’ disclosure. The Examiner must be pushed to a conclusion as to the patentability of Claim 11 by the teachings of the references themselves, or what is known in the art just before the invention was made. The Examiner cannot be drawn to a modification due to careful study of Applicants’ disclosure.

Khan does not digitally notarize a product document with a timestamp and a digital fingerprint

The arguments regarding Donner and a product document were presented in the Request for Reconsideration dated September 26, 2006. In the interest of brevity, the arguments are referenced, but not repeated.

For all the reasons noted above, Claim 11 is patentable over the cited references. Claims 2-10, 13-16, and 19-22, dependent from Claim 11, enjoy the same distinction with respect to the cited references.

Claim 33

Claim 33 is an apparatus claim paralleling method Claim 11. Applicants have shown that Claim 11 is patentable over the cited references. Therefore, Claim 33 also is patentable over the cited references. Claims 24-32, 35-38, and 41-44, dependent from Claim 33, enjoy the same distinction with respect to the cited references.

Applicants courteously request that the rejection be removed.

The Objection of Claims 17, 18, 39, and 40 as Being Dependent Upon a Rejected Base Claim

Claims 17, 18, 39, and 40 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 11 is allowable. Therefore, Claims 17 and 18, dependent from Claim 11, no longer depend upon a rejected base claim. Claim 33 is allowable. Therefore, Claims 39 and 40, dependent from Claim 33, no longer depend upon a rejected base claim.

Applicant courteously request that the objection be withdrawn.

Attorney Docket No. IPCP:107US
U.S. Patent Application No. 09/931,492
Reply to Office Action of December 15, 2006
Date: February 12, 2007

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

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Dated: February 12, 2007